

REMARKS

Formal Matters

Rejection Under 35 USC §112, Second Paragraph

Claims 11-39 stand rejected under 35 USC §112, Second Paragraph. (Paper No. 5 at page 3). In making the rejection, the Examiner simply states that Claims 1-39 are “indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” *Id.* For the reasons set forth below, the rejection is hereby traversed.

It is well settled, that all that is required to comply with 35 USC §112, second paragraph, is that the metes and bounds of what is claimed be determinable with a reasonable degree of precision and particularity. *Ex parte Wu*, 10 USPQ2d 2031, 2033 (BPAI 1989). To reject a claim under the second paragraph of 35 USC §112, it is incumbent on the Examiner to establish that one of ordinary skill in the pertinent art, when reading the claims in light of the supporting specification, would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims. *Ex parte Wu*, 10 USPQ2d 2031, 2033 (BPAI 1989).

Here the Examiner has not made any factual determination that establishes that one of ordinary skill in the art “would not have been able to ascertain with a reasonable degree of precision and particularity the particular area set out and circumscribed by the claims.” For this reason alone, the rejection cannot stand and should be withdrawn.

Claims 11-39 recite various processes for the preparation of high purity lower alkyl esters. Applicants respectfully assert that there is nothing vague or indefinite about any of the recited processes. One skilled in the art would readily recognize what is being claimed. Nothing more is required, and the Examiner has not articulated any facts to support the rejection.

According to MPEP §2171 “if a rejection is based on 35 USC §112, second paragraph, the Examiner should further explain whether the rejection is based on indefiniteness or on the failure to claim what applicants regard as their invention.” MPEP §2171 citing *Ex parte Ionescu*, 222 USPQ 537, 539 (Bd. App. 1984). Here the Examiner has done neither. Moreover, in discussing the proper procedures for rejecting claims under 35 USC §112, second paragraph, MPEP §706.03(d) states that

“ a full explanation of the deficiency of the claims should be supplied.” It is further stated that whenever possible the Examiner should “identify the particular term(s) or limitations(s) which render the claim(s) indefinite.” *Id.* Therefore, Applicants respectfully assert that the Examiner’s rejection is insufficient as a matter of law to support a rejection under 35 USC §112, second paragraph, or in the alternative to provide Applicants any guidance with which to make a substantive response.

It is respectfully submitted that the scope of claims 11-39 is readily ascertainable to one skilled in the art when the claims are read in light of the description portion of the Specification, and the state of the art as of the filing date of the present application.

In rejecting Claims 11-39 in the manner described above the Examiner has referred with specificity only to Claims 37-39. With respect to Claim 37 the Examiner appears to express concern over the fact that various process parameters are not recited. The legal standard for definiteness, however, is whether a claim reasonably apprises those of skill in the art of its scope. *In re Warmerdam*, 31 USPQ 2d 1754, 1759 (Fed. Cir. 1994). Here, the claims meet that standard by explicitly reciting specific process steps in the present invention. The claims apprise what the invention is and 35 USC §112, second paragraph, does not require that the claims recite every combination or permutation of how it can be done. Therefore, it is respectfully submitted that this rejection, under 35 USC §112, second paragraph, is improper and should be withdrawn.

With respect to Claims 38-39 the Examiner states that the limitation of “esterified polyol” in line 2 has insufficient antecedent basis. Applicants respectfully traverse the rejections.

MPEP §2173.05(e) states that “if the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite.” MPEP §2173.05(e) citing *Ex parte Porter*, 25 USPQ2d 1144, 1145 (Bd. Pat. App. & Inter. 1992). Here Claim 38 is directed to the alkyl ester product of Claim 37, made by the process steps described therein, that further comprises an “esterified polyol selected from the group consisting of esterified alkoxylated glycerols, esterified linked alkoxylated glycerols, sucrose fatty acid polyesters and mixtures thereof.” The term “esterified polyol” in Claim 38 refers to an additional component of the alkyl ester product of Claim 37. Claim 37 uses “comprising” as the transitional phrase, which is an “open” term that leaves the claim at issue open for the inclusion of unspecified

components. Support for the term “esterified polyol” can be found at page 1, lines 22-23; page 2, line 5; page 18, line 12; and throughout the remainder of the Specification and Claims 1-10 as originally filed. As such, Applicants respectfully assert that the scope of the Claim 38 is clearly ascertainable to those skilled in the art and, therefore, that the rejection is in error and should be withdrawn.

With respect to Claim 39, Applicants respectfully bring to the Examiner’s attention that this claim does not contain the term “esterified polyol.” As such, Applicants respectfully assert that the rejection is in error and should be withdrawn.

ART REJECTIONS

Rejection Under 35 USC §102(b)

The Examiner has rejected Claims 11-13, 17-18, 20, and 32 as being anticipated under 35 USC §102(b) by EP 0 391 485 A1 to Klok. For the reasons set forth below, the rejection is respectfully is traversed.

The Examiner has rejected Claims 11-13, 17-18, 20, and 32 over EP 0 391 485 A1 stating that the cited reference “teaches a process of preparing fatty acid lower alkyl esters wherein esters are formed via esterification, by-products separated via conventional water washing, the water-washed ester produced is distilled to produce an ester product of at least 98% purity, an acid value of less than 1.0, under elevated temperatures and pressure.” (Paper No. 5 at page 2). Applicants respectfully suggest that the Examiner’s conclusion that the reference anticipates the present invention is in error.

As is well settled, anticipation requires “identity of invention.” *Glaverbel Societe Anonyme v. Northlake Mktg. & Supply*, 33 USPQ2d 1496, 1498 (Fed. Cir. 1995). Each and every element recited in a claim must be found in a single prior art reference and arranged as in the claim. *In re Marshall*, 198 USPQ 344, 346 (CCPA 1978); *Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir 1984).

Furthermore, in a §102(b) rejection there must be no difference between what is claimed and what is disclosed in the applied reference. *In re Kalm*, 154 USPQ 10, 12 (CCPA 1967); *Scripps v. Genentech Inc.*, 18 USPQ2d 1001, 1010 (Fed. Cir. 1991). “Moreover, it is incumbent upon the Examiner to identify wherein each and every facet of the claimed invention is disclosed in the applied reference.” *Ex parte Levy*, 17 USPQ2d 1461, 1462 (BPAI 1990). The Examiner is required to point to the

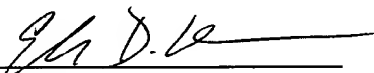
disclosure in the reference "by page and line" upon which the claim allegedly reads. *Chiong v. Roland*, 17 USPQ2d 1541, 1543 (BPAI 1990).

The present rejection fails to identify where in the cited reference (EP 0 391 485 A1) each and every element of the rejected claims are shown. Specifically, the rejection fails to identify where it is disclosed in the cited reference that the step of water washing the product mixture should be done at an elevated temperature and an elevated pressure to remove at least a portion of the by-products from the product mixture. The EP 0 391 485 A1 reference neither discloses nor suggests that the step of water washing should be performed at either elevated temperatures or elevated pressures. This is insufficient as a matter of law to support a conclusion of anticipation, and for this reason, the rejection is improper and should be withdrawn.

Conclusions

Applicants have made an earnest effort to place their application in proper form. WHEREFORE, reconsideration of this application, withdrawal of the rejections under 35 USC §102(b), 35 USC §112, Second Paragraph, and allowance of Claims 11-39 are respectfully requested.

Respectfully submitted,
For Corey J. Kenneally, et al.

By 

Erich D. Hemm

Attorney for Applicants

Registration No. 47,286

Tel. No. (513) 634-2084

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